

69. The invention of Claim ~~19, 20, or 21~~ wherein the support structure comprises a single rail assembly.

70. ~~The invention of Claim 69 wherein the single rail assembly is substantially centered with respect to the diaphragm.~~

71. The invention of Claim 69 wherein the rail assembly comprises first and second laterally-separated elements positioned to restrict upward movement of the guide, said elements extending along an axial direction defined by the rail assembly.

72. The invention of Claim 69 wherein the guide comprises first and second guide elements positioned below the first and second rail assembly elements, respectively.

<sup>33</sup> 73. The invention of Claim ~~71~~ wherein the first and second rail assembly elements comprise respective downwardly-facing surfaces.

<sup>33</sup> 74. The invention of Claim ~~71~~ wherein the first and second elements comprise respective horizontally-extending flanges.

#### Remarks

Applicant appreciates the willingness of Examiner Hartmann to meet with the undersigned attorney in an interview held March 28, 2001. The following paragraphs include a summary of the substance of the interview.

Applicant appreciates the allowance of Claim 18. The remaining claims have been rejected only under 35 U.S.C. § 251 as an improper recapture of broadened claimed subject matter that was surrendered in the application for patent upon which the present reissue is based.

#### Allowed Claim 18 and Related Claims 29 and 69-74

As a preliminary matter, applicant wishes to point out that Claim 29 is similar to allowed Claim 18 in defining the support structure as comprising a single rail. Applicant submits that the outstanding rejection of Claim 29 should be withdrawn for the same reasons that Claim 18 was allowed (with respect to the recapture doctrine).

Additionally, applicant has added new Claims 69-74 which should also be allowable. Note that Claim 69 defines the support structure as comprising a single rail assembly. The term "rail assembly" is supported by the application as filed. Note, for example, the discussion in Column 4, Lines 10-15, which clearly defines the guide rail as made up of multiple plates and flanges. New Claim 70 defines that the single rail assembly is substantially centered with respect to the diaphragm. New Claim 71 defines the single rail assembly as comprising first and second laterally separated elements positioned to restrict upward movement of the guide, said elements extending along the axial direction defined by the rail assembly. These elements are supported by the flanges 29 that are shown, for example, in Figures 5 and 6. New Claim 72 defines the guide as comprising first and second guide elements positioned below the first and second elements, respectively. This claim is supported by the guide elements 80 of Figure 6. New Claim 73 defines the first and second elements as comprising respective downwardly facing surfaces. This claim is supported by the downwardly facing surfaces of the flanges 29 (Figure 6). New Claim 74 defines the first and second elements as comprising respective horizontally extending flanges. This claim is supported by the flanges 29 of Figure 6 (Column 4, Line 14).

Applicant submits that new Claims 69-74 all include the single rail assembly limitation, and are all free of the recapture doctrine for the same reasons as is allowed Claim 18.

#### Rejected Claims 19-68

With respect to the rejection of Claims 19-68 under 35 U.S.C. § 251, applicant requests reconsideration. These claims include three independent claims (Claims 19, 20 and 21). Claims 19 and 21 define the diaphragm as coupled to a leg assembly extending beneath the diaphragm on at least one side out board of the support structure to support the diaphragm on the support surface. This claim language will be referred

to below as the outboard leg limitation. Claim 20 defines the support structure as comprising at least two axially aligned, releasably interconnected support structure segments (the "segmented support structure" limitation).

In the parent application, applicant responded to an initial restriction requirement by focusing that application on the rail invention. The non-elected inventions related to other aspects of the highway crash cushion including the leg assemblies (Group II), the fender panels (Groups III and IV), and the energy absorbing element (Group V). The rail invention was originally defined as a single centered rail. During prosecution, applicant argued that the single centered rail distinguished Claim 1 from the prior art initially. In the second response, Claim 1 was amended to define that at least some of the diaphragms are each coupled to a respective leg assembly extending beneath the respective diaphragm on both sides of the rail to support the diaphragm on a support surface. With this amendment, Claim 1 was allowed.

Claims 19-68 are narrower than the original Claim 1 of the parent application, and there is therefore no improper recapture.

*Ball Corporation v. U.S.*, 221 USPQ 289 (Fed. Cir. 1984), sets forth the recapture doctrine. As set out in the conclusion on page 297, when a claim in reissue is broader in scope than the originally issued claims, but narrower in scope than the canceled (or unamended original claims), there is no improper recapture. Applicant submits that that is the case here. Originally, Claim 1 of the parent application did not call for any leg, and it was amended as described above to call for at least one leg assembly extending beneath the respective diaphragm on both sides of the rail to support the diaphragm on a support surface. Claims 19 and 21 include the outboard leg limitation and Claim 21 includes the segmented support structure limitation. Thus, all three of these independent claims (and therefore all of the rejected claims) are narrower than Claim 1 of the parent application prior to amendment. As such, under the rule set down in the *Ball* case, there is no improper recapture.

All of the recapture cases prior to *Hester Industries v. Stein Incorporated*, 46 USPQ 2<sup>nd</sup> 1641 (Fed. Cir. 1998), dealt with recapture in the context of claim amendment. That is, prior to *Hester* there had never been a recapture found with respect to a claim element that had not been amended during prosecution. However, in

*Hester* the Federal Circuit found it an improper recapture in a case where claim limitations that were argued to support a patentability were deleted from the reissue claims, and where the reissue claims included no materially narrowing limitations.

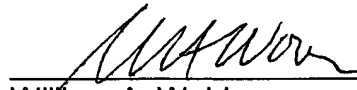
The present case is quite different from the facts of the case decided by the *Hester* court, in that applicant has not simply removed the single rail limitation. Instead, applicant has removed the single rail limitation and added other material limitations that overcome the recapture rule. In particular, Claims 19 and 21 include the outboard leg limitation and claim 20 includes the segmented support structure limitation. Thus, the present case is quite different from *Hester*, and applicant submits that there is no case law that has gone so far as to apply the recapture rule to claims such as those proposed in the present reissue application. Only *Hester* finds a prohibited recapture for a claim element that was not amended during original prosecution, and in *Hester* the argued claim element was deleted from the reissue claim without the addition of material limitations. Applicant submits that it would be an improper extension of the recapture doctrine to find that Claims 19-68 are barred by the rule of the *Hester* case.

In this connection, applicant wishes to point out that the MPEP clearly recognizes that there is no prohibited recapture of surrendered subject matter if a narrowing limitation is added that modifies the claim in such a manner that the scope of the claim no longer results in a recapture of surrendered subject matter. See MPEP Section 1412.02, page 1411(Rev. 1, Feb. 2000).

Conclusion

Applicant submits in view of the foregoing amendment and remarks, Claims 19-74 are all in condition for allowance. Applicant intends to file a Supplemental Declaration once an indication has been received that all claims are allowable. For this reason, no Supplemental Declaration is enclosed with this paper.

Respectfully submitted,



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